

REMARKS

The Official Action mailed October 30, 2009, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statement filed on August 18, 2009.

However, the Applicant has not received acknowledgment of the Information Disclosure Statements filed on July 14, 2006, and August 21, 2006 (received by OIPE August 23, 2006). The Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the above-referenced Information Disclosure Statements.

Claims 1-48 are pending in the present application, of which claims 1, 2, 5-7 and 44-47 are independent. Claims 1-12 and 44-48 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 1 and 7-12 as anticipated by U.S. Patent No. 6,497,371 to Kayanakis. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claims 1 and 7 have been amended to recite a thin film integrated circuit comprising a thin film transistor having a semiconductor film of thickness of 0.2 μm or less, supported in the specification, at least, at page 2, line 12, and at page 6, line

6. The Applicant respectfully submits that Kayanakis does not teach the above-referenced feature of the present invention, either explicitly or inherently.

Since Kayanakis does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

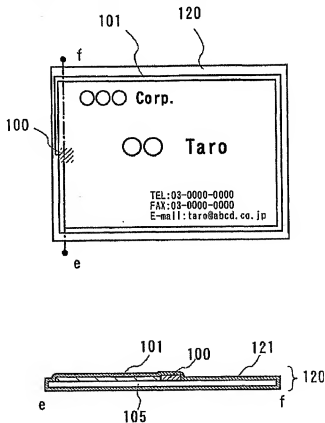
Paragraph 4 of the Official Action rejects claims 2-6 and 13-48 as obvious based on Kayanakis. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. As in independent claims 1 and 7, independent claims 44, 46 and 48 have been amended to recite a thin film integrated circuit comprising a thin film transistor having a semiconductor film of thickness of 0.2 μm or

less. It is respectfully submitted that Kayanakis does not teach or suggest the above-referenced features of the present invention.

Independent claim 2 recites a thin film integrated circuit capable of storing information described on the film-like article; and an antenna connected to the thin film integrated circuit, wherein the thin film integrated circuit is mounted inside the film-like article, and the antenna is mounted on a surface of the film-like article. Such an orientation is illustrated by Figures 4A and 4B, reproduced below, which illustrates antenna 101 mounted on a surface of the film-like article.



In addition, independent claim 5 recites wherein the thin film integrated circuit and the antenna are mounted on a surface of the film-like article; independent claim 6 recites wherein the thin film integrated circuit is mounted on a surface of the film-like article, and the antenna is mounted inside the film-like article; independent claim 45 recites mounting the thin film integrated circuits and the antenna on a surface of a base

member of the film-like article; and independent claim 47 similarly recites forming an antenna on a surface of the base member of the film-like article so that the thin film integrated circuit and the antenna are connected through an opening formed on the base member of the film-like article.

The Official Action concedes that Kayanakis teaches "the circuit and antenna being mounted inside the film-like article is met by the chip(22) and antenna(24) being mounted inside of paper layers(18 and 20) (Paper No. 20091025, page 2; emphasis added). It is respectfully submitted that Kayanakis does not teach or suggest the above-referenced features of the present invention. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit (KSR International Co. v. Teleflex Inc., 550 U.S. ___, 82 USPQ2d 1385). The Court quoting In re Kahn (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR, 550 U.S. at ___, 82 USPQ2d at 1396. In the present application, with respect to at least the above-referenced features of claims 2, 5, 6, 45 and 47, the Official Action appears to contain mere conclusory statements, and the Official Action has not set forth articulated reasoning with some rational underpinning to support the assertion of *prima facie* obviousness. If a rejection is maintained with respect to the above-referenced claims and based on the present prior art of record, then the Applicant respectfully requests that the Official Action provide specific references to the prior art to support the rejections and provide clear articulation of the reasons why the claimed invention would have been obvious to one of ordinary skill in the art at the time of the present invention.

Dependent claims 8-12 have been amended to recite a substrate, wherein an opening with slits is provided in the substrate, wherein the thin film integrated circuit is electrically connected to the antenna through the opening in the substrate. These features are supported in the specification, at least, by Figures 1B to 1D, and their

corresponding descriptions in the present specification. It is respectfully submitted that Kayanakis does not teach or suggest these features of the present invention.

Since Kayanakis does not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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